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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,462	07/23/2003	Laurie Ann Holtzberg	8285-636	1320

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EXAMINER	
ESCALANTE, OVIDIO	

ART UNIT	PAPER NUMBER
2614	

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/626,462	HOLTZBERG, LAURIE ANN	
	Examiner	Art Unit	
	Ovidio Escalante	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 July 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to applicant's amendment filed on July 24, 2006. **Claims 1-24** are now pending in the present application.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-12 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,8 and 12, of U.S. Patent No. 6,625,261. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims in the continuation are broader than those in the patent..

For example, claim 1 of the application is the same as claim 12 of the patent except claim 1 of the application does not require the voicemail message to be stored in a voicemail database and does not require not receiving a rewind command from a user.

Claims 5 and 9 of the application are the same as claims 1 and 8, respectively of the patent for the same reasons as stated above.

Claims 2-4,6-8,10-12 are rejected because they depend upon a rejected claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 13-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Kuter et al. US Patent 6876729.

Regarding claims 13, 17 and 21, Kuter teaches a method for bookmarking a voicemail message and telecommunication system and a computer-usable medium storing a computer program product (abstract; col. 3, lines 9-25) comprising:

a switch, (fig. 1); and

a processor in communication with the switch (col. 3, lines 45-64; fig. 1) and operative to:

(a) playing back a voicemail message, (col. 3, lines 26-44); then

(b) receiving a bookmark request during the playing back of the voicemail message, (col. 3, lines 26-44); then

(c) receiving a request for playing back the voicemail message, (col. 3, lines 26-44); and then

(d) instead of playing back the voicemail message from a start of the voicemail message, playing back the voicemail message starting at a point preceding a point in the voicemail

message at which the bookmark request was received without receiving a rewind command from a user, (col. 4, lines 19-42).

Regarding claims 14, 18 and 22, Kuter, as applied to claims 13,17 and 21, teaches wherein the bookmark request includes a timing offset value that defines a period of time preceding a point in the voicemail message at which the bookmark request was received, and wherein (d) comprises playing back the voicemail message starting at the period of time preceding the point in the voicemail message at which the bookmark request was received, (col. 4, lines 19-42).

Regarding claims 15 and 23, Kuter, as applied to claims 14 and 22, teaches wherein the voicemail message is stored in a database, and wherein the method further comprises determining a memory location within the stored voicemail message based on the timing offset value, (col. 4, lines 19-42).

Regarding claims 16, 20 and 24, Kuter, as applied to claims 13,17 and 21, teaches wherein (a)-(d) are performed by a service node, (fig. 5; col. 3, lines 45-64).

Regarding claim 19, Kuter, as applied to claim 17, teaches a voicemail database storing the voicemail message, wherein the voicemail database is in communication with the processor, (col. 3, lines 45-64).

Response to Arguments

6. Applicant's arguments filed July 24, 2006 have been fully considered but they are not persuasive.

Applicant contends that since claim 5 does not recite all the features of claim 1 of the Holtzberg patent, claim 5 is of a different scope from claim 1 of the Holtzberg patent, and

an obviousness-type double patenting rejection is not proper. The Examiner respectfully disagrees.

The double-patenting rejection was made based on the fact that the claims in the present application are the same scope and are broader than those in the patent. The Examiner agrees that for example, "claim 5 does not include a service node in communication with a switch; a memory operatively coupled to a processor; a user interface program stored in the memory; and a voice playback subsystem coupled to the processor." As stated by the applicant, since claim 5 does not include those features, then claim 5 is broader than that of claim 1 of the patent and thus claim 5 would be anticipated by claim 1 of the patent. Therefore, the Examiner maintains that the double-patenting rejection is proper and claims 1-12 will stand rejected on the ground of nonstatutory obviousness-type double patenting.

Applicant contends that Kuter does not teach playing back the voicemail message starting at the preceding point without receiving a rewind command from a user, at the bookmark request point. The Examiner respectfully disagrees.

In col. 4, lines 35-43, as cited in the office action, Kuter clearly states that the "second additional step paces the bookmark and the additional bookmarks at locations that are a specific time duration before an actual selection of the bookmark and the additional bookmarks. The example provided by Kuter states that bookmarks are places at utterance beginning locations by using the first alternative method. The second alternative method will move the bookmark a specific time duration before the utterance. Therefore, Kuter clearly teaches that the playing can start at a preceding point without receiving a rewind command from a user.

Applicant contends that Kuter does not teach that the voicemail message is stored in a database since Kuter only discloses the use of a storage medium and a storage medium alone is not a database. The Examiner respectfully disagrees.

Kuter teaches that the storage medium can be a plurality of different types including a computer disk drive and where the storage media is part of a messaging server. Since the storage medium stores information for a server and since the storage medium stores the bookmarking files, the storage medium is clearly a database. Furthermore, database, as broadly defined is merely a collection of files that can be accessed by a computer-based system. Therefore, since the files of Kuter are accessed by a computer then Kuter clearly meets the claimed limitation of a database.

Applicant contends that Kuter is silent on using a service node to perform any of the features since Kuter only discloses a processing unit 104 which is not a service node or a point at a network node where service users access the services offered by service providers. The Examiner respectfully disagrees.

The Examiner notes that the claims do not define what a service node is and that the claims do not claim that the service node is a network node that process service users access to services offered by service providers. Service node is a broad term in itself and thus can be interpreted as any node that can provide a service. Since the processing unit of Kuter provides a service for its users, then it reads on a service node.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Or:

(571) 273-7537, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to:

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ovidio Escalante whose telephone number is 571-272-7537. The examiner can normally be reached on M-Th from 6:30AM to 4:00PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S. Tsang can be reached on 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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October 6, 2006

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